IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jan Henk Kamps	RECEIVED CENTRAL FAX CENTER OCT 13 2005
Application No.: 10/768,575	
Filed: 01/29/2004	Group Art Unit: 1711
Title: Process for the Production of Copolycarbonates with Reduced Color	Examiner: Boykin, Terressa M
Attorney Docket No.: GEPL.P-070	

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Response Under 37 CFR 1.111

Dear Sir:

This paper is filed in response to the Official Action mailed August 10, 2005 for the above-captioned application. Reconsideration of the application in light of the following remarks is respectfully requested.

The Examiner rejected all claims (i.e. 1-45) under 35 USC 112 first paragraph stating,

> Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the broadly defined {"substantial polymerization.
>
> The specification on page 5 lines 21-22 specifically disclose the copolycarbonate is less than 5,000.." are not commensurate in scope with these claims. *See* page 2 of the office action.

I hereby certify that this paper and any attachments named herein are transmitted to the United States Patent and Trademark Office, Fax number: (571) 273-8300 on October 13, 2005.

Ryan E. Anderson, USPTO #51,405

October 13, 2005
Date of Signature

Applicants are unable to determine what the Examiner is trying to say in these recitations, since it appears to say that the claims are enabled. While Applicants submit that this is true, it is inconsistent with the statement that the claims are rejected. Accordingly, Applicants respectfully request the Examiner to correct her 112 first paragraph rejection or in the alternative to withdraw it.

The Examiner also rejected all claims (i.e. 1-45) under 35 USC 112 second paragraph stating,

> Claim 1-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
>
> The recited "substantial polymerization" as set forth in the claims is unclear with regards to the extent that the reaction proceeds. As read in view of the specification on page 5, the production of an oligomeric intermediates or products would also be interpreted as substantial polymerization. No clear definition appears to be present in the specification to clearly defined the meets and bounds of applicants intended meaning. *See* pages 2 and 3 of the office action.

Applicant's respectfully traverse this rejection. The phrase *substantial polymerization* is used in the claims to define the catalyst introduction strategies of the present invention. Namely, the first and second catalyst introduction strategy refer to adding the catalyst to the reaction components prior to *substantial polymerization*. Page 5 of the specification defines prior to *substantial polymerization*, as it is used with reference to the catalyst introduction strategies, as where the average molecular weight (M_w) of the copolycarbonate is less than 5,000 (PS standards).

All of the claims of the present application refer to the steps of: selecting a catalyst introduction strategy from a list of strategies that call for adding the catalyst prior to *substantial polymerization*; introducing the catalyst to the reaction components per the selected strategy; and further polymerizing the reaction mixture to form the resulting copolycarbonate. There is nothing indefinite about this. As stated on page 21, last paragraph, the product may be an oligomer or a larger polymer. "Substantial polymerization" only relates to this to the extent that further polymerization occurs after catalyst addition.

The undersigned reminds the Examiner of the holding in *Ex parte Cordova*, 10 U.S.P.Q. 2d 1949 (POBAI 1989). In rejecting a claim under 112 second paragraph, "it is incumbent on the Examiner to establish that one having ordinary skill in the art would not have been able to determine the scope of protection defined by the claim when read in light of the specification." *Id.* at (p 1952). As demonstrated above, the Examiner has failed to establish that one having ordinary skill would not be able to determine the scope of the present claims, since the present claims, when read in light of the specification, clearly define the scope of protection. Therefore, the Examiner's 112 second paragraph rejection should be withdrawn.

Response to Provisional Double Patenting Rejection:

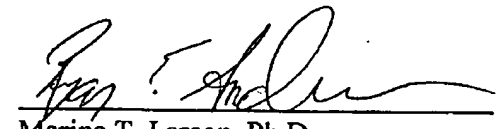
The Examiner has also provisionally rejected claims 1-41 for obviousness-type double patenting over claims 1-51 Serial No. 10/925,833. Applicants respectfully traverse this rejection, since the Examiner has failed to look at the claims of the two applications. Claims 1-51 of the cited application relate to a method of producing a copolycarbonate in which color is controlled by introduction of an antioxidant. No claim in the present application contains such a limitation. Therefore, Claims 1-41 of the present application can be practiced without infringing on claims of the cited application. Thus, claims 1-41 of this application are clearly independent and distinct from claims 1-51 of the cited application.

Claims 49-51 of the cited application recite the combination in which both the catalyst addition strategy of the present application and the antioxidant addition step are employed to control color in the product. These claims are thus of the type that are described in MPEP § 806.5(d), that is claims 49-51 of the cited reference are a combination of two subcombinations that are useable together. Since restriction of the claims if presented in the same application would have been proper, the presentation of the claims in two applications, only one of which (i.e. the cited reference) contains the combination claims, does not justify an obviousness-type double patenting rejection. Withdrawal of the rejection is therefore requested.

In view of the foregoing remarks, Applicants submit that the claims conform to the statutory requirements and are allowable. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited. No fee is

believed to be due with the filing of this paper, however the Commissioner is authorized to charge any fee deemed due to Deposit Account 15-0160.

Respectfully Submitted,



Marina T. Larson, Ph.D
Reg. No. 32,038

Ryan E. Anderson
Reg. No. 51,405

Attorneys for Applicant(s)
(970) 468 6600